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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,635	09/15/2003	Sanjay Agraharam	Cont. of 10/127,070	9757

26652 7590 03/24/2005

AT&T CORP.
P.O. BOX 4110
MIDDLETOWN, NJ 07748

EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/662,635

Applicant(s)

AGRAHARAM ET AL.

Examiner

Ovidio Escalante

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/15/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendment filed on November 15, 2004. **Claims 1-8,10-24** are now pending in the present application.

Terminal Disclaimer

2. The terminal disclaimer filed on November 15, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,654,448 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3,5,6,10,17,18 and 21-23 rejected under 35 U.S.C. 102(e) as being anticipated by Finnigan US Patent 6,173,043.

Regarding claims 1,21 and 22, Finnigan teaches a method and system for transmitting a message to an intended recipient (abstract; col. 2, lines 8-21) comprising:

receiving an oral message for the intended recipient from a sending party (col. 4, lines 40-49);

converting the oral message into a text message using speech recognition software, (col. 5, lines 36-49);

receiving information regarding the intended recipient from the sending party at the time the intended recipient provides the oral message, (col. 4, lines 49-58); and

transmitting the text message to the intended recipient, wherein the received information regarding the intended recipient from the sending party is used to obtain a destination for the transmitting the text message to the intended recipient, (col. 4, lines 49-58; col. 5, lines 12-49).

Regarding claim 2, Finnigan, as applied to claim 1, teaches wherein transmitting the text message further comprises e-mailing the text message to the recipient, (col. 5, lines 42-46).

Regarding claim 3, Finnigan, as applied to claim 1, teaches wherein transmitting the text message further comprises faxing the text message to the recipient, (col. 5, lines 46-49).

Regarding claim 5, Finnigan, as applied to claim 3, teaches determining a facsimile phone number for the intended recipient by accessing a database, (col. 2, lines 22-33).

Regarding claims 6 and 23, Finnigan, as applied to claims 2 and 22, teaches determining an e-mail address for the intended recipient by accessing a database, (col. 4, line 59-col. 5, line 11, 42-49).

Regarding claim 10, Finnigan, as applied to claim 1, teaches storing information related to the transmitted text message, (col. 4, line 59-col. 5, line 11).

Regarding claim 17, Finnigan, as applied to claim 1, teaches wherein the receiving the information regarding the intended recipient from the sending party at the time the intended recipient provides the oral message further comprises:

receiving an oral message including a destination address of the intended recipient, (col. 4, lines 46-58).

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Regarding claim 18, Finnigan, as applied to claim 1, teaches wherein the receiving the information regarding the intended recipient from the sending party at the time the intended recipient provides the oral message further comprises:

entering, by the sender, the information via a keypad, (col. 4, lines 52-54).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finnigan in view of Ibuka US Patent 6,058,164.

Regarding claim 16, Finnigan, as applied to claim 1, does not specifically teach of determining that the voice mail box is full and converting the oral message to a text message when the voice mail box is full.

In the same field of endeavor, Ibuka teaches determining whether a voice mail box associated with the recipient is full, wherein:

the converting the oral message to the text message is performed when the determining determines that the voice mail box associated with the intended recipient is full, (col. 47, lines 2-13,23-31,55-63).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Finnigan by using the teaching of converting the receive voice message to a text message when the voice storage is full as taught by Ibuka so that the storage capacity of the voice memory can be used more efficiently and so that the message recipient can receive all messages even if there is no more space to store the message in the voice message device.

9. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bijl et al. US Patent 6,173,259 in view of Raud et al. US Patent 6,125,311.

Regarding claim 13, Bijl teaches an answering service, (voice mail service; col. 5, lines 16-26; abstract), the answering service being configured to perform:

receiving an oral message from a sender for a recipient, (col. 4, lines 47-51; col. 5, lines 16-32);

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converting the oral message into a text message, (col. 8, lines 41-44; col. 9, lines 16-30,62-67); and

transmitting the text message to the recipient, (col. 4, lines 24-34).

Bijl does not specifically teach of querying the sender with respect to whether restricted domain is to be used.

In the same field of endeavor, Raud teaches querying the sender with respect to whether a restricted domain is to be used when converting the oral message into a text message, (col. 2, lines 47-col. 3, line 11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Bijl by querying the sender with respect to whether restricted domain is to be used so that the most accurate voice recognition software program can be selected.

Regarding claim 14, Bijl, teaches wherein converting the oral message into a text message occurs using speech recognition software, (col. 8, lines 42-57; col. 9, lines 16-30,62-67).

Regarding claim 15, Bijl in view of Raud, teaches wherein converting the oral message into a text message further comprises:

applying the restricted domain during the converting of the oral message to the text message when the sender indicates that the restricted domain is to be used, (col. 3, lines 3-11).

As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Bijl by querying the sender with respect to

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whether restricted domain is to be used so that the most accurate voice recognition software program can be selected.

10. Claims 4,7,8,11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finnigan in view of Cohn et al. US Patent 6,064,723.

Regarding claim 4, while Finnigan, as applied to claim 1, teaches of transmitting a text message to the recipient, Finnigan does not specifically teach of sending and instant message.

In the same field of endeavor, Cohn teaches that it was well known in the art to convert an oral message to a text message and to instantaneously transmit the text message to the message recipient, (col. 34, lines 2-8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Finnigan, by instantaneously sending the text message as taught by Cohn so that the message recipient can receive the message promptly.

Regarding claim 7, while Finnigan as applied to claim 1, teaches of transmitting the text to the intended recipient, Finnigan does not specifically teach of notifying the sender of the oral message of the status of the message.

In the same field of endeavor, Cohn teaches that it was well known in the art to send notification information which includes status information to the sender of the message, (col. 31, lines 9-12).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Finnigan by notifying the message originator of the status of the message as taught by Cohn so that the message sender will know whether or not the message was delivered.

Regarding claims 8, Finnigan, as applied to claim 1, does not specifically teach wherein the oral message is received on an integrated services network.

In the same field of endeavor, Cohn teaches that it was well known in the art to receive an oral message on an integrated services network, (col. 31, lines 9-12; fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Finnigan by receiving the oral message on an integrated services network as taught by Cohn so that a higher bandwidth network can be used to send the message to the recipient. This will allow larger files to also be transferred faster.

Regarding claims 11 and 12, while Finnigan, teaches of having subscribers, Finnigan does not teach of billing either the recipient or the sender.

In the same field of endeavor, Cohn teaches that it was well known the art to bill the intended recipient of the text message and the sender of the oral message, (col. 30, lines 49-52; col. 33, lines 56-63)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Finnigan by billing the message sender or recipient so that the system can receive funds for operating its service to users.

Regarding claims 19, 20 and 24, Finnigan, as applied to claim 1, does not specifically teach receiving a name of the intended recipient.

In the same field of endeavor, Cohn teaches wherein the receiving the information regarding the intended recipient form the sending party at the time the intended recipient provides the oral message further comprises: receiving a name of the intended recipient, (col.

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34, lines 55-65). Cohn further teaches accessing a database to determine a destination address for the text message based on the received name, (col. 34, lines 54-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Finnigan by receiving a name of the intended recipient at the time the intended recipient provides the oral message as taught by Cohn so that the message sender can identify the message recipient.

Response to Arguments

11. Applicant's arguments with respect to claims 1-8,10-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any response to this action should be mailed to:

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 746-5969, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

220 20th Street S.
Crystal Plaza two, Lobby, Room 1B03
Arlington, VA 22202

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 703-308-6262 (571-272-7537 After March 22, 2005). The examiner can normally be reached on M-Th from 6:30 to 4:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S Tsang can be reached on 703-305-4895 (571-272-7547 After March 22, 2005). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**OVIDIO ESCALANTE
PATENT EXAMINER**

Ovidio Escalante

Ovidio Escalante
Examiner
Group 2645
March 16, 2005

O.E./oe



**FAN TSANG
SUPERVISORY PATENT EXAMINER
BIOLOGY CENTER 2600**